



**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/977,400	11/24/97	LU	P HALO-010

MM92/0908  
TRIAL & TECHNOLOGY LAW GROUP  
545 MIDDLEFIELD ROAD SUITE 220  
MENLO PARK CA 94025

EXAMINER

MAIL A

ART UNIT

PAPER NUMBER

2832

#15

DATE MAILED: 09/08/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
08/977,400

Applicant(s)

LU Et Al.

Examiner

Anh Mai

Group Art Unit

2832



☒ Responsive to communication(s) filed on Jul 6, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-8 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-8 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 2832

## DETAILED ACTION

### *Continued Prosecution Application*

1. The request filed on July 6, 2000 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/977,400 is acceptable and a CPA has been established. An action on the CPA follows.

### *Drawings*

2. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In the claims 1-2, 5, and 7-8 what does applicant intend by "carried within"? A package is the device claimed. The transformers can not be carried within the package. They are part of the package. Clarification is required.

Art Unit: 2832

What does applicant intend by "the foot seating plane of the package"? There is no antecedent basis for "the foot seating plane of the package".

In claim 2, there is no antecedent for "the wall" [line 7]. It is not clear if applicant intends "side wall" or "end wall".

*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCormick on paper "Surface Mount Transformers: A New Packaging Approach" in view of Matsumura et al. [US 5034854].

McCormick discloses:

- a one-piece construction package having side wall and an open bottom;
- two toroid transformers positioned inside the package;
- the transformers having wires wrapped thereon;
- a plurality of terminal pins molded within and extending through and below a bottom of the side wall [figures 1, 2].

Art Unit: 2832

McCormick discloses the instant claimed invention except for one end of the pins having notched solder and the other end of each pin extending in gull wing fashion outwardly from and below the bottom of the side wall.

Matsumura discloses an enclosed transformer having:

- silicone resin 49 filled within [figure 12; col 7, lines 25-32];
- the post are separated from one another [figure 9];
- a safeguard formed by bottom end of casing [figure 9];
- end walls having first height H1 to form standoff between the foot seating plane and terminal pins;
- outer portion of the side wall extending between the end walls and having second height H2;
- terminal 31 provided with a notch 33 [figure 11c, col 5, lines 30-42] and the other end of the pins extending in gull wing fashion [figure 16].

It would have been obvious to a person of ordinary skill in the art to add notches to one end of the pins and the other end having gull wing shape as taught by Matsumura to McCormick. The motivation would have been to facilitate the mounting of the winding end and terminal connection. Therefore, it would have been obvious to combine Matsumura with McCormick.

#### *Response to Arguments*

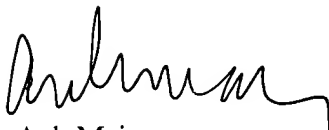
5. Applicant's arguments with respect to claims 1-8 have been considered but are moot in view of the new ground(s) of rejection.

**Art Unit: 2832**

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anh Mai whose telephone number is (703) 308-2900.

If attempt to reach the examiner by phone unsuccessful, the examiner's supervisor, Michael Gellner, can be reached at (703) 308-1721.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist of the Technology Center whose telephone number is (703) 308-0956. The facsimile numbers for Technology Center 2800 are (703) 305-3432/3431.



Anh Mai

September 6, 2000